

## **REMARKS**

### **Introduction**

Claims 1 - 19 were originally pending in this application. Claims 1, 6, 8, and 9 were previously amended, and claims 3 – 5, 7, and 11 were previously cancelled. Claims 1, 2, 6 – 10, and 12 – 19 have been rejected. By way of this response, claims 1, 2, and 8 have been amended, claims 6, 9, 10, and 12 - 14 have been cancelled, and claim 20 has been added. Thus, claims 1, 2, 8, and 15 – 20 remain pending for consideration in the application. No new matter has been added.

### **Claim Rejections**

#### **35 U.S.C. §103(a)**

Claims 1, 2, 6, 8 - 10, 12 - 15, and 17 - 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Hansen '586 patent in view of the Kuntz '880 patent. More specifically, the Examiner stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hansen to include a spring-biased dowel mount as taught by Kuntz since such a structure is a conventional alternative structure used for the same intended purpose, thereby providing structure as claimed. Also, the Examiner stated that the structure of the Hansen device can both be cantilevered-supported and supported by a leg structure as a structure is entitled to all of its uses. Furthermore, the examiner has given judicial notice that use of clips and a recess for structures in trays is well-known and commercially used. In addition, the Examiner stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify one mount for another mount since such structures are conventional alternative structures used for the same intended purpose of providing an attachment.

Moreover, claim 16 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Hansen '586 patent in view of the Kuntz '880 patent as applied to the claims above and further in

view of the Sammons '202 patent. More specifically, the Examiner stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the invention of Hansen to include a peripheral edge as taught by Sammons since such a structure is a conventional structure used for the same intended purpose, thereby providing structure as claimed.

Independent claim 1 has been amended to make it clearer and more concise and exact. The applicants cannot agree that the invention defined in amended claim 1 would have been obvious over the Hansen '586 patent in view of the Kuntz '880 patent. Claims 2 and 8 were also amended to make them clearer and more concise and exact, and claims 6, 9, 10, and 12 - 14 have been cancelled. Each of claims 2, 8, and 15 - 19 is ultimately dependent upon independent claim 1. Accordingly, these rejections are respectfully traversed.

### **The Prior Art**

#### **The Hansen '586 Patent**

The Hansen '586 patent discloses a portable desk 10 for hanging from the rear portion 56 of a seat back 54. The desk 10 includes a table board 12 having substantially planar upper and lower surfaces 14, 16, a top portion 22, and a bottom portion 24. Each of a pair of mounting brackets 28, 30 has a mounting portion 32, 36 securable to the lower surface 16 of the table board 12 and an attachment portion 34, 38 extending beyond the top portion 22 of the table board 12. The attachment portion 34, 38 includes a connection member 40, 42 for releasable attachment to a top 58 of the seat back 54. Support members 46, 48 extend from the lower surface 16 of the table board 12 for bracing the table board 12 against the rear portion 56 of the seat back 54 to define an operational angle of the desk 10 relative to the seat back 54. Finally, a support ledge 26 is disposed along the upper surface 14 of the table board 12 near the bottom portion 24 to provide a brace for materials placed on the upper surface 14 of the table board 12 during use of the desk 10.

In operation, the attachment portions 34, 38 of the respective mounting brackets 28, 30 are placed underneath the top 58 of the seat back 54 so as to engage the corresponding connection members 40, 42 with the top 58. Thus, the top 58 seats in juncture 60, which is defined between the connection members 40, 42 and their respective attachment portions 34, 38. Once this engagement has been accomplished, the table board 12 is allowed to fall and rotate about the juncture 60.

However, the Hansen '586 patent does not disclose or suggest a portable tray for use at multiple locations of the interior of a vehicle including a spring-biased dowel. More specifically, this patent fails to disclose or suggest the spring-biased dowel extending substantially along an edge of a body of the tray and adapted to be removably disposed between and in contacting relationship with a pair of opposed, spaced structural components of the interior of the vehicle and apply a retaining force in opposite directions with respect to the disposition of the spring-biased dowel and against the structural components. In this way, the body is operatively supportable to the interior of the vehicle in cantilevered and stationary fashion.

Furthermore, the Hansen '586 patent does not disclose or suggest a portable tray for a vehicle interior including a pair of opposed mounting tabs. More specifically, this patent fails to disclose or suggest a pair of opposed mounting tabs extending outwardly from respective transverse sides of a body of the tray and adapted to be received by a pair of corresponding recesses defined in a respective pair of opposed, spaced structural components of the interior of the vehicle to removably support the body to the structural components. In this way, the body is operatively supportable to the interior of the vehicle in cantilevered and stationary fashion, and the tray can be manually moved and used at various locations within the interior of the vehicle.

### **The Kuntz '880 Patent**

The Kuntz '880 patent discloses a tissue-roll mounting bracket 43, a roll of toilet tissue 24, and a toilet-tissue mounting roll 50. The mounting roll 50 includes a left side 22 having an outer portion 39 of reduced diameter and a right side 23 having an outer portion 40 of reduced diameter. The mounting bracket 43 has a left-side portion 41 and a right-side portion 42. The outer portion 40 of the right side 23 of the mounting roll 50 has an outwardly-biased right stub portion 44, and the outer portion 39 of the left side 22 of the mounting roll 50 has an outwardly-biased left stub portion 45. Partial opening 48 in the right-side portion 42 of the mounting bracket 43 allows for reception of the right stub portion 44 in the right-side portion 42 of the mounting bracket 43 whereas partial opening 49 of the left-side portion 41 of the mounting bracket 43 allows for reception of the left stub portion 45 in the left-side portion 41 of the mounting bracket 43.

However, the Kuntz '880 patent does not disclose or suggest a portable tray for use at multiple locations of the interior of a vehicle.

### **The Sammons '202 Patent**

The Sammons '202 patent discloses a serving tray adapted to be secured to a dashboard of an automobile and swung outwardly when it is desired to use the tray and about a pivot to be positioned behind or forwardly of the dashboard when the tray is not in use. The tray includes a body portion 1 formed with an upstanding flange 2 surrounding the body portion 1. A pair of spaced combined-bearing-and-hinge members 3, 4 are integrally formed with the body portion 1 and located on one side and adjacent opposite ends of the tray. Locking means are formed in the combined-bearing-and-hinge member 3, 4 for supporting the tray in an extended position when the tray is in use and for locking the tray in a retracted or hidden position when the tray is not in use.

However, the Sammons '202 patent does not disclose or suggest a portable tray for use at multiple locations of the interior of a vehicle including a spring-biased dowel and at least one leg. Furthermore, the Sammons '202 patent does not disclose or suggest a portable tray for a vehicle interior including a pair of opposed mounting tabs. More specifically, this patent fails to disclose or suggest a pair of opposed mounting tabs extending outwardly from respective transverse sides of a body of the tray and adapted to be received by a pair of corresponding recesses defined in a respective pair of opposed, spaced structural components of the interior of the vehicle to removably support the body to the structural components. In this way, the body is operatively supportable to the interior of the vehicle in cantilevered and stationary fashion, and the tray can be manually moved and used at various locations within the interior of the vehicle.

### **The Present Invention**

In contrast to the references of record in this case, the present invention as described in amended independent claim 1 is directed toward a portable tray for use at multiple locations of the interior of a vehicle. The tray includes a body adapted to be operatively supported to the interior of the vehicle and defines at least one substantially planar work surface. A spring-biased dowel is connected to the body and adapted to removably support the body to a pair of opposed, spaced structural components of the interior of the vehicle such that the tray can be manually moved and used at various locations within the interior of the vehicle. The spring-biased dowel extends substantially along an edge of the body and is adapted to be disposed between and in contacting relationship with the structural components and apply a retaining force in opposite directions with respect to the disposition of the spring-biased dowel and against the structural components. The body is operatively supportable to the interior of the vehicle in cantilevered and stationary fashion. The body includes at least one leg extending from the body and adapted to be supported against at

least one structural component of the interior of the vehicle such that the tray is operatively supportable against the interior of the vehicle in non-cantilevered and stationary fashion.

Also in contrast to the references of record in this case, the present invention as described in newly added independent claim 20 is directed toward a portable tray for use at multiple locations of the interior of a vehicle. The tray includes a body adapted to be operatively supported to the interior of the vehicle and defines at least one substantially planar work surface. A pair of opposed mounting tabs extend outwardly from respective transverse sides of the body and are adapted to be received by a pair of corresponding recesses defined in a respective pair of opposed, spaced structural components of the interior of the vehicle to removably support the body to the structural components. In this way, the body is operatively supportable to the interior of the vehicle in cantilevered and stationary fashion, and the tray can be manually moved and used at various locations within the interior of the vehicle.

### **Argument**

#### **35 U.S.C. § 103(a)**

The Examiner asserts that the Hansen '586 patent discloses the invention as defined in claim 1 of the present application, except for the mounting structure of the Hansen invention not being a spring-biased dowel, and that the Kuntz '880 patent discloses use of an outwardly extending spring-biased dowel to provide for a mount. The Examiner also asserts that it would have been obvious to one of ordinary skill in the art at the time the present invention was made to modify the invention of Hansen to include a spring-biased-dowel mount as taught by Kuntz since such a structure is a conventional alternative structure used for the same intended purpose, thereby providing structure as claimed.

According to MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the prior-art references themselves or knowledge generally available to one of ordinary skill in the art, to modify the primary reference or combine teachings of the respective references. Second, there must be a reasonable expectation of success. Third, the reference (or combined references) must teach or suggest all the claim limitations. The suggestion or motivation to make the claimed combination and the reasonable expectation of success must both be found in the prior art. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With respect to such suggestion or motivation, “[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (A combination of the references taught every element of the claimed invention; however, without a motivation to so combine, a rejection based on a *prima facie* case of obviousness was held improper.). Obviousness can only be established by combining or modifying teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. In re Kahn, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching requirement as a guard against using hindsight in an obviousness analysis). The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to motivation to combine references).

However, a claimed combination cannot render the prior art unsatisfactory or inoperable for its intended purpose or change the principle of operation of the primary reference. More specifically,

if a proposed modification would render the prior-art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01. Also, if the proposed modification or combination of the prior art would change the principle of operation of the prior-art invention being modified, then the respective teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP § 2143.01.

In addition, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990). (Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”) Moreover, a statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the respective teachings of the references. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993).

Here, the Hansen desk 10 relates particularly to a portable desk for hanging from the rear portion of a seat back. One object of the Hansen desk 10 is to provide a portable desk adapted for hanging from the top edge of a seat back, and another object is to provide a portable desk that may be attached to the seat handles typically found on seats in buses and commuter railroad cars (column 1; lines 58 – 60, 64 – 67). In fact, the “hanging” feature of the Hansen desk 10 is mentioned no fewer than 9 times in the disclosure of the Hansen ‘586 patent. Thus, an intended purpose of the Hansen desk 10 is to provide a portable desk for hanging from the top edge of a seat back. And, to hang the



Hansen desk 10, it is necessary only to place the attachment portions 34, 38 underneath the top 58 of the seat back 54 so as to engage the corresponding connection members 40, 42 with the top 58. Thus, the top 58 seats in the juncture 60. Once this engagement has been accomplished, the table board 12 is allowed to fall and rotate about the juncture 60 (column 3; lines 60 - 67). Therefore, the principle of operation is only to place the attachment portions 34, 38 underneath the top 58 of the seat back 54 so as to engage the corresponding connection members 40, 42 with the top 58 such that the table board 12 is allowed to fall and rotate about the juncture 60.

However, if the Hansen desk 10 were modified to replace the mounting brackets 28, 30 with the Kuntz “spring-biased dowel” (combination of the outwardly-biased right and left stub portions 44, 45, respectively) to insure that the Hansen desk 10 could be operatively supported to the interior of the vehicle in cantilevered and stationary fashion, then the Hansen desk 10 would be inoperable for its intended purpose because the desk 10 would no longer be “hangable.” In particular, placement of the “spring-biased dowel” 44, 45 underneath the top 58 of the seat back 54 so as to engage the “spring-biased dowel” 44, 45 with the top 58 would render falling and rotation of the table board 12 about the juncture 60 unsatisfactory or inoperable. In this instance, the proposed modification of the Hansen desk 10 would at least change the principle of operation of the Hansen desk 10 from a “hangable” one to a “non-hangable” one. Accordingly, the respective teachings of the Hansen ‘586 and Kuntz ‘880 references are not sufficient to render amended claim 1 *prima facie* obvious.

Even assuming the mounting brackets 28, 30 of the Hansen desk 10 were not eliminated, presence of the mounting brackets 28, 30 would at least substantially limit the number of locations where the Hansen desk 10 could be supported to the pair of spaced structural components of the interior of the vehicle or possibly even prevent any such support. More specifically, if the length of the longer mounting bracket 28, 30 were any longer than the length of either structural component,

then the Hansen desk 10 could not be supported there . . . the mounting brackets 28, 30 would be in the way and, thus, not permit the “spring-biased dowel” 44, 45 to be disposed between and in contacting relationship with the structural components. In this instance, the proposed modification would render the Hansen desk 10 at least unsatisfactory, if not inoperable, for its intended purpose of applying a retaining force against the structural components to operatively support the modified Hansen desk 10 to the interior of the vehicle in cantilevered and stationary fashion. Accordingly, there is no suggestion or motivation to make the proposed modification.

According to the final “Office Action,” the Examiner fully considered the applicants’ arguments filed on September 18, 2006, but is not persuaded by them. However, the Examiner cites no objective evidence in support of his position other than that “it would have been obvious to one of ordinary skill in the art at the time the present invention was made to modify the invention of Hansen to include a spring-biased-dowel mount as taught by Kuntz since such a structure is a conventional alternative structure used for the same intended purpose, thereby providing structure as claimed.” Yet, as already explained above, the spring-biased-dowel mount as taught by Kuntz is not used for the same intended purpose as is that of the mounting brackets 28, 30 of the Hansen desk 10, namely, for “hanging.” Anyway, as Ex parte Levengood makes absolutely clear, making such a statement (merely because the Hansen ‘586 and Kuntz ‘880 references teach that all aspects of the claimed invention were individually known in the art) is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the respective teachings of the Hansen ‘586 and Kuntz ‘880 references.

Contrarily, the applicants have relied herein on the objective evidence found in the disclosure of the Hansen ‘586 patent in the form of no fewer than nine pronouncements therein to the effect that the intended purpose of the Hansen desk 10 is to provide a portable desk for *hanging* and exclusive principle of operation of the Hansen desk 10 is *hanging*. The applicants have also made reference to

specific facts with respect to motivation to combine the Hansen desk 10 with the Kuntz “spring-biased dowel” 44, 45 and respectfully submit that there absolutely is no such motivation.

### **New Claim 20**

Independent claim 20 has been added to the present application and incorporates some of the limitations of each of claims 1 and 9 and all of the limitations of each of claims 12 – 14. Essentially, claim 20 defines a portable tray that substantially parallels that defined in claim 1, except that a pair of opposed, spaced mounting tabs replace the spring-biased dowel of claim 1. Support for this new claim is found in Figures 1 - 4 and 10 and corresponding text of the present application.

For the reasons set forth above in connection with patentability of the portable tray defined in amended independent claim 1 over the combination of the Hansen desk 10 with the Kuntz “spring-biased dowel” 44, 45, the portable tray defined in new independent claim 20 is patentable. First, the mounting brackets 28, 30 of the Hansen desk 10 are not used for the same intended purpose as are the mounting tabs of claim 20, thereby not providing structure as claimed. Second, there is no suggestion or motivation to modify the Hansen desk 10 or combine respective teachings of the Hansen ‘586 and Kuntz ‘880 references. Third, the mere fact that such teachings *can* be combined or the Hansen desk 10 *can* be modified does not render the resultant combination or modification obvious since the prior art also does not suggest the desirability of the combination. Fourth, the references relied upon teaching that all aspects of the claimed invention are individually known in the art is not sufficient to establish a *prima facie* case of obviousness since there is no objective reason to combine the respective teachings of the references. Based upon these reasons, applicants respectfully submit that it would be improper to conclude that modifications of the prior art to meet the claimed invention are well within the ordinary skill of the art at the time the claimed invention was made.

As can be easily seen, modifying the Hansen desk 10 to include the Kuntz “spring-biased dowel” 44, 45 does not result in the portable tray for use at multiple locations of the interior of a vehicle of the type described in each of amended independent claim 1 and new independent claim 20. The suggested combination of the respective teachings of the Hansen ‘586 and Kuntz ‘880 patents would require a change in the intended purpose of the Hansen desk 10 and basic principle under which the Hansen desk 10 was designed to operate. More specifically, the suggested combination would render the Hansen desk 10 unsatisfactory or inoperable for providing a portable desk for hanging from the top edge of a seat back. In particular, merely adding the Kuntz “spring-biased dowel” 44, 45 to the Hansen desk 10 would render it unsatisfactory for “hanging” while replacing the mounting brackets 28, 30 with the Kuntz “spring-biased dowel” 44, 45 would render it inoperable for “hanging.”

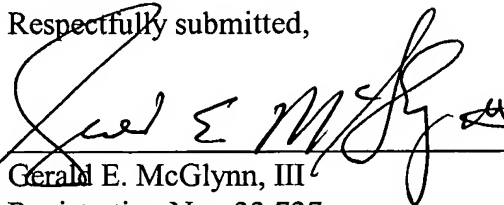
The deficiencies in the teachings of the combination of the Hansen ‘586 and Kuntz ‘880 patents are not overcome in the disclosure of the Sammons ‘202 patent. Thus, none of the references, alone or in combination with either or both of the other references, discloses or suggests the portable tray for use at multiple locations of the interior of a vehicle described in amended claim 1 or new claim 20.

The applicants respectfully submit that independent claim 1, as amended, recites structure that is not disclosed or suggested by the prior art and is patentably distinguishable from the subject matter of the references of record in this case. Claims 2, 8, and 15 – 19 are all ultimately dependent upon amended claim 1 and add further perfecting limitations thereto. Also, the applicants respectfully submit that new independent claim 20 recites structure that is not disclosed or suggested by the prior art and is patentably distinguishable from the subject matter of the references of record in this case. As such, the prior-art references, in combination with each other or each reference standing alone, do not suggest the subject invention as defined in these claims.

### Conclusion

Independent claim 1, as amended, recites structure that is neither disclosed nor suggested by the prior art and is patentably distinguishable from the cited art discussed above. Each of claims 2, 8, and 15 – 19 is dependent upon amended claim 1 and adds further perfecting limitations. Accordingly, the applicants respectfully request that the rejections be withdrawn. Also, new independent claim 20 recites structure that is neither disclosed nor suggested by the prior art and is patentably distinguishable from the cited art discussed above. Accordingly, the applicants respectfully solicit allowance of the claims pending in this case.

Respectfully submitted,



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